

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	PETROV, et al.		
Serial No.:	09/819,772	Group Art Unit:	2624
Filing Date:	March 28, 2001	Examiner:	G. Cunningham
For:	TOOLS FOR 3D MESH AND TEXTURE MANIPULATION		

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Mail Stop Appeal Brief - Patents
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REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

Sir:

Appellant submits the present Reply Brief in response to the Examiner's Answer mailed February 28, 2008.

First, Appellants wish to inform the Office that the real party in interest in the present appeal has changed its name from Viewpoint Corporation to Enliven Marketing Technologies Corporation. The address as provided in the Appeal Brief remains the same.

Second, for the reasons set forth in the Appeal Brief and those set forth below, it is again respectfully submitted that the final rejections of claims 2-10, 55-63 and 114-117 should be reversed.

Appellant incorporates herein arguments previously presented in the Appeal Brief dated December 19, 2007. In addition, the following comments are presented to further highlight the differences between the claimed subject matter and the applied prior art reference.

MatLab does not inherently anticipate the claimed invention because it does not perform the claimed method in its normal operation

Appellants respectfully disagree with the Examiner's characterization of their argument in the Appeal Brief. Appellants have not admitted that "MatLab meets the claimed invention, but lacks the element of any user having done so" (as the Examiner states at Answer at p. 18). Appellants are also not arguing that the claims of the present application recite a "user" (as the Examiner states at Answer at p. 18).

Appellants are arguing that the Examiner is applying the wrong legal standard to his analysis. As stated in the MPEP, "if a prior art device, in its normal and usual operation, would *necessarily* perform the method claimed, then the method claimed will be considered to be anticipated." MPEP § 2112.02 (emphasis added). The reference cited by the Examiner as inherently anticipating the present claims, MatLab, is a programming environment that allows a user to combine various commands and functions to perform tasks desired by the user.¹ MatLab does not necessarily perform any act that a user has not programmed it to do. Instead of showing that MatLab had been programmed to carry out the combination of steps recited in the claims or necessarily carries out the combination of steps recited in the claims, the Examiner's rejections simply pick and choose from the programming functionality of MatLab to show that each individual step potentially *could be* programmed from the functionality provided in the MatLab environment. This is improper because "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation." MPEP § 2106; *see also, e.g., Diamond v. Diehr*, 450 U.S. 175, 188-89 (1981) ("In determining the eligibility of respondents' claimed process for patent protection under § 101, their claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis. This is particularly true in a process claim because a new combination of steps in a process may be patentable even though all the constituents of the combination were well known and in common use before the combination was made."). Here, the Examiner has not shown that a user has ever assembled (or been instructed to assemble) the combination of steps recited in the present claims. Rather the Examiner has used the claims as a

¹ This is where the references to a "user" come from in the Appeal Brief. MatLab by itself does nothing without a user to program it.

guide to picking and choosing functionality from MatLab that potentially could be used to program MatLab to carry out the claimed steps. This is insufficient because the Examiner has not shown that MatLab, “in its normal and usual operation, would necessarily perform the method claimed.”

This failure is not overcome by the Examiner’s reference to the MatLab Primer’s invitation to “freely experiment” and “to try this or that combination” (Answer at page 19). Absent any instruction or suggestion to try the particular combination of steps that make up the claimed invention, one cannot conclude that MatLab, “in its normal and usual operation, would necessarily perform the method claimed.”

Furthermore, under the Examiner’s reasoning virtually any computer implemented process would be inherently anticipated by almost any computer programming language simply because the commands necessary to program a computer to carry out the claimed process existed in the programming language even absent any evidence that a computer had ever been so programmed.

For the foregoing reasons and for the reasons more fully set forth in the Appeal Brief, it is respectfully submitted that the final rejections of the pending claims should be reversed.

The Commissioner is authorized to charge Kenyon & Kenyon LLP Deposit Account No. 11-0600 for any applicable fee.

Respectfully submitted,

Dated: April 28, 2008

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